

Appl. No. : 09/457,207  
Filed : December 7, 1999

2. (Amended) The device of claim 1 further comprising a second communication port coupled to the signal reporting circuit and configured to communicate with the computer.

#### REMARKS

Claims 1-11 are pending in the application and are presented for reconsideration and further examination in view of the foregoing amendments and the following remarks. By the foregoing amendments, claims 1 and 2 have been amended.

The specific changes to the amended claims are shown on a separate set of pages attached hereto and entitled VERSION WITH MARKINGS TO SHOW CHANGES MADE, which follows the signature page of this Amendment. On this set of pages, the insertions are underlined while the [deletions are bolded and enclosed within brackets].

In the Office Action, claims 1-11 were rejected under 35 U.S.C. § 102(e) as being anticipated by Simmons (U.S. Patent No. 5,195,414). Applicant reserves the right to challenge whether Simmons is available as prior art in the present application.

Simmons describes a device for emulating a line card within a channel bank of a public switched telephone network (PSTN). The device is described as being capable of emulating line card impairments such as robbed bit signaling, digital trunk loss, network delay, inter-modulation distortion, analog loss and echo. Simmons appears to be addressing the issue of providing telephone network simulation equipment while addressing the variability in the performance of CODECs. Applicant respectfully submits that Simmons does not anticipate or make obvious the claims of the present application.

With regard to claim 1, the claim is directed to a device for testing the operation of a modem in a computer. The claim includes a first communication port "configured to receive signals from a modem in a computer." On the other hand, Simmons describes in Figure 1A a PCM modem 170 in communication with a personal computer 180 via an RS-232 serial connection. The application states that the personal computer is used for data analysis. (Simmons, column 6, lines 23-42). Simmons does not appear to teach or suggest testing a modem within a personal computer, but rather describes testing a modem and using a personal computer to analyze the data from the test.

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Further, claim 1 includes a signal reporting circuit which is coupled to the first communication port and is configured to "test and evaluate the transmit capability of the modem in the computer." In the Office Action, element 855 of Figure 8B of Simmons was pointed to as meeting this limitation. The Office Action went on to state that Simmons "teaches outputting a sample and thus this is equivalent to reporting the signal." However, Applicant respectfully submits that the outputting of a sample by Simmons is intended to exercise or test the modem. It does not appear that the network simulator of Simmons performs any analysis or reporting of analysis results. Therefore, Applicant respectfully submits that Simmons does not anticipate or make obvious claim 1. Claims 2-4 depend from claim 1 and are at least patentable for the reasons set forth above in connection with claim 1.

In addition, with regard to claim 2, claim 2 adds a further limitation of a second communication port coupled to the signal reporting circuit and configured to communicate with the computer. No such communication port is taught or suggested by Simmons. Simmons does not indicate any ports which provide communication between the PC and the network simulator.

Independent claims 5, 8 and 11 are directed to methods for testing the operation of a modem in a computer using a portable modem testing device. Simmons does not meet the limitations of each of these claims.

For example with regard to claim 5, claim 5 includes the limitation of, *inter alia*, coupling the modem in the computer to the portable modem testing device. Simmons does not discuss modems in computers and also does not describe coupling a portable testing device to a modem in a computer.

Further, with regard to claim 6 which depends from claim 5, claim 6 includes the further steps of coupling the computer to the portable modem testing device by an alternate communication link and transmitting a signal from the portable modem testing device to the computer via the alternate communication link. In the Office Action, it appears that the capability of the card described in Simmons to have both digital or analog connections is being pointed to as meeting this limitation. However, Simmons merely describes that either a digital or an analog type connection can be simulated. Simmons does not describe a connection to the modem in the computer and a separate connection to a separate port in the computer. Simmons also does not teach or describe transmitting signals from the testing device to the computer via

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such a link. The transmission of such signals allows for, for example, more automated testing and evaluation of the modem in the computer. No such link is shown or described in Simmons. That is not surprising given that the line card emulating device of Simmons does not appear to perform any analysis.

Applicant respectfully submits that claim 5 and claims 6 and 7 which depend therefrom are not anticipated or made obvious in view of Simmons.

Claim 8 is directed to a method of testing the operation of a modem in a computer using a portable modem testing device wherein the modem in the computer is coupled to the portable modem testing device. Data is then transmitted from the portable modem testing device. That data is received at the modem in the computer which then verifies the transmission. No such method is taught or suggested by Simmons.

Again, Simmons does not teach or suggest coupling the modem in the computer to the portable modem device. Simmons only describes the use of a computer for analyzing the performance of a modem. The computer is coupled to the modem via an RS-232 port. The modem is not in the computer.

In addition, claim 9 adds the further limitations of coupling the computer to the portable modem testing device by an alternate communication link and transmitting a signal from the computer to the portable modem testing device via the alternate communication link. As with claim 6 above, no such alternate link between the testing device and a computer is taught or suggested by Simmons.

Applicant respectfully submits that independent claim 8 and dependent claims 9 and 10 are not anticipated or made obvious by Simmons.

Finally, independent claim 11 is also directed to a method of testing the operation of a modem in a computer using a portable modem testing device. Claim 11 includes, *inter alia*, coupling the modem in the computer to the portable modem testing device, receiving test data at the modem from the portable device, verifying the transmission, and initiating transmission of test data from the portable testing device which is received at the modem in the computer.

First, Applicant notes that the network simulator of Simmons does not appear to generate test data. Simmons describes his system wherein station A transmits to station B through the network simulator, and wherein station B transmits to station A through the network simulator.

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The network simulator merely provides the connection between the source and destination. That is unlike the presently claimed invention wherein the portable modem testing device receives and verifies transmissions from that modem in the computer and generates transmissions to the modem in the computer. Therefore, Applicant respectfully submits that claim 11 is patentable over Simmons.

#### Conclusion

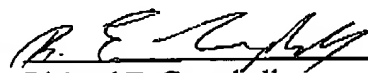
The Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: 10/7/02

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

1. (Amended) A device for testing the operation of a modem in a computer, the device comprising:

a case;

a first communication port attached to the case and configured to receive signals from a modem in a computer; and

a signal reporting circuit located within the case and coupled to the first communication port, the signal reporting circuit configured to test and evaluate the transmit capability of [a] the modem in [a] the computer.

2. (Amended) The device of claim 1 further comprising a second communication port coupled to the signal reporting circuit and configured to communicate with the computer.